

### **REMARKS**

Claims 11-28 are pending. Claims 12, 13 and 19 are currently amended. Applicant respectfully requests entry of the amendments since they should put the claims in condition for allowance. Reconsideration of the application is requested.

### **Claim Objections**

Claims 13 and 19 have been amended as suggested by the Examiner to remove claim objections.

### **§ 103 Rejections**

Claims 11 and 26 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over Masaki et al. (JP 10-077308 Machine Translation provided by Examiner) in view of Akihiro et al. (JP H2000-230162A1 Machine Translation provided by Examiner). The Examiner has pointed out that for the purpose of searching for and applying prior art under 35 USC 102 or 103, absent clear indication in the specification or claims of what the basic and novel characteristics actually are, the recitation “consisting essentially of” will be construed as equivalent to “comprising.” (MPEP 2111.03). The Applicant would also like to point out that this section of the MPEP also states that “If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention.”

The Examiner has asserted that Masaki et al. discloses an adhesive tape free of halogen and that the tape comprises a base material and a PSA disposed on the base material. The Examiner further states that the acrylic polymer of Masaki is formed of a mixture comprising (a) 50-98 wt% of (meth)acrylic ester monomer ((alkyl)methacrylate) and (b) one or more of copolymerizable monomers copolymerized with monomer (a) in the amount of 2 to 50 wt%; wherein the monomer (b) can be of carboxyl group containing monomers such as acrylic acid, fumaric acid and/or nitrogen containing monomers such as N-vinyl pyrrolidone. Further the Examiner points out that Example 2 of Masaki discloses a PSA formed of an acrylic polymer

that is a mixture containing units derived from isononyl acrylate, acrylic acid, and N-vinyl pyrrolidone.

Applicants respectfully traverse these rejections for at least the following reason. The Applicant's claim 11 comprises a base material and a PSA consisting essentially of an alkyl(meth)acrylate monomer, a nitrogen-containing monomer, a carboxyl group-containing monomer, and a metal hydrate compound. (emphasis added). The flame retardant composition of Masaki contains either one of (i) fibrous filler, (ii) porous fine particles, (iii) non-polar resin fine particles, and (iv) organic fine particles. (see [57] abstract). The purpose of the invention of Masaki is to provide an adhesive tape with high fire retardancy, and high shear strength and peel strength (see [0005]). The means of solving the problem is to incorporate a filler (see [0006]). The specification of Masaki suggests in many places (paragraphs [0019] – [0028]) that the purpose of adding the filler(s) is to increase shear strength of the adhesive. The Applicant contends that the purpose of the filler is to change the characteristics (i.e., shear strength and adhesion) of the pressure sensitive adhesive and thus Masaki et al is excluded by the recitation of “consisting essentially of”. As a result, Masaki is not proper prior art for rejection of Applicant's claim 11. The application of Akihiro by the Examiner is mute. Therefore, the rejection by the Examiner of claim 11 under 35 USC § 103(a) as purportedly being unpatentable over Masaki et al. (JP 10-077308 Machine Translation provided by Examiner) in view of Akihiro et al. (JP H2000-230162A1 Machine Translation provided by Examiner) is improper and should be withdrawn.

Claim 26 adds additional features to claim 11. Claim 11 is patentable for the reasons given above. Thus, claim 26 is likewise patentable.

In summary, the rejection of claims 11 and 26 under 35 USC § 103(a) as being unpatentable over Masaki in view of Akihiro has been overcome and should be withdrawn.

Claims 11-28 stand rejected under 35 U.S.C. 103(a) as purportedly being unpatentable over Moon et al. (US 4,988,742) in view of Blance et al. (US 3,632,412) and Akihiro et al. (JP H2000-230162 Machine Translation). It is the Examiner's position that Moon discloses an acrylic terpolymer PSA and PSA tapes comprising acrylic terpolymer PSA. And that Moon discloses a multilayer tape construction wherein coatable composition (i.e. PSA adhesive) are

coated to provide a plurality of superimposed layers. The Examiner also asserts that Moon is silent as to teaching presence of halogen in his/her adhesive tape. The Examiner is relying on Blance to show that it is known in the adhesive art to use alkyl acrylate and alkyl (meth)acrylate monomers interchangeably. It is the Examiner's position that Moon as modified by Blance is silent as to teaching the metal hydrate compound in the PSA and its amount. The Examiner is relying on Akihiro to provide that teaching.

The Applicant has amended claims 12 and 19 to recite that the adhesive compositions consist essentially of the cited components. Moon (4,988,742) teaches an acrylic terpolymer pressure sensitive adhesive that has "a hydrogenated rosin ester tackifying agent" (see abstract and col. 5, lines 27-43). The purpose of the tackifier is to "show improved adhesion over solvent-polymerized acrylic pressure-sensitive adhesives containing about 4 to 8 times as much rosin ester tackifier." Thus, the tackifier of Moon changes the adhesion characteristics of the pressure sensitive adhesive and Moon should be excluded as prior art with Applicant's amendments. Furthermore, the Examiner has stated that "for the purpose of searching for and applying prior art under 35 USC 102 or 103, absent clear indication in the specification or claims of what the basic and novel characteristics actually are, the recitation 'consisting essentially of' will be construed as equivalent to 'comprising' ". The Applicant respectfully asserts that the specification on page 2, lines 12-25 recites that the addition of tackifiers to metal hydrate-containing pressure sensitive adhesives can compensate for a decrease in adhesive strength but does not allow for adequate holding strength in the adhesive. Thus, Applicants intentionally exclude tackifiers from the claimed compositions of amended claims 12 and 19 and by using "consisting essentially of", exclude the Moon reference. Since amended claims 12 and 19 now exclude tackifiers and Moon, the rejection of claims 12 and 19 under 35 U.S.C. 103(a) is unwarranted and should be withdrawn.

Claims 13-18, ultimately depend upon amended claim 12 and add further limitations thereto. Claims 20-25 and 27-28 ultimately depend upon amended claim 19 and add further limitations thereto. Since amended claims 12 and 19 are now patentable, likewise so are claims 20-25 and 27-28.

Claims 11 and 26 are also patentable over Moon for the same reason as stated above but are not amended so they should be allowed without amendment.

In view of the above, it is submitted that the application is in condition for allowance.

Examination and reconsideration of the application is requested for claims 11 and 26.

Examination and reconsideration of the application as amended is requested for claims 12-25 and 27-28.

Respectfully submitted,

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Date

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